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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,487	03/26/2001	Susanne Dagmar Pippig	4-31193A	9170

1095 7590 06/03/2003

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NOVARTIS, CORPORATE INTELLECTUAL PROPERTY  
ONE HEALTH PLAZA 430/2  
EAST HANOVER, NJ 07936-1080

EXAMINER

LI, RUIXIANG

ART UNIT	PAPER NUMBER
1646	(8)

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/817,487	PIPPIG ET AL.	
	Examiner Ruixiang Li	Art Unit 1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 March 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9, 11, 12, 14, 17-20 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4, 6-9, 11, 12, 14, and 17-20 is/are rejected.
- 7) Claim(s) 5 and 25-28 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 03 March 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>15</u> . | 6) <input type="checkbox"/> Other: _____                                     |

## **DETAILED ACTION**

### **I. Status of Application, Amendments, and/or Claims**

The amendment filed in Paper No. 16 on March 3, 2003 has been entered in full. Claims 1, 7, 12, 14, and 17-20 have been amended. Claims 10, 15, 16, 21, 23, and 24 have been canceled. Claims 27 and 28 have been added. Claims 1-9, 11, 12, 14, 17-20, and 25-28 are pending and are under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

### **II. Drawings**

The formal drawings submitted on March 3, 2003 in Paper No. 14 are accepted by the Examiner.

### **III. Information Disclosure Statement**

The references listed in the Information Disclosure Statement filed on March 3, 2003 in Paper No. 15 have been fully considered.

### **IV. Supplemental Declaration**

The Supplemental Declaration submitted on March 31, 2003 in Paper No. 17 has been received by the office. However, it is noted that the declaration fails to claim the

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benefit under 35 U.S.C. § 119 (e) of the provisional application, 60/266,331, filed on March 30, 2000.

#### **V. Withdrawn Objections and/or Rejections**

The rejection of claims 15 and 21 under 35 U.S.C. §112, 1<sup>st</sup> paragraph (Scope Enablement), as set forth at pages 3 to 5 of the previous Office Action (Paper No. 12, September 3, 2002), has been withdrawn in view of applicants' cancellation of the claims.

The rejection of claims 1-12, 14-21, and 23-26 under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as set forth at page 5 of the previous Office Action (Paper No. 12, September 3, 2002), has been withdrawn in view of applicants' amendment to the claims.

The rejection of claims 10 and 21 under 35 U.S.C. §102 (a) as being anticipated by Zhou et al. (*J. Cell Biology* 146:1133-1146, September 6, 1999), as set forth at pages 5-6 of the previous Office Action (Paper No. 12, September 3, 2002), has been withdrawn in view of applicants' cancellation of the claims.

The rejection of claims 15, 16, 23, and 24 under 35 U.S.C. §103(a) as being unpatentable over Bordignon et al. (WO 95/06723, March 9, 1995) in view of Zhou et al. (*J. Cell Biology* 146:1133-1146, September 6, 1999), as set forth at pages 7-8 of the previous Office Action (Paper No. 12, September 3, 2002), has been withdrawn in view of applicants' cancellation of the claims.

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The objection of claims 18-20 for minor informalities as set forth at page 9 of the previous Office Action (Paper No. 12, September 3, 2002), has been withdrawn in view of applicants' amendment to the claims.

#### **VI. Claim Rejections Under 35 U. S. C. § 102 (a)**

The rejection of claims 1-4, 6-8, 11, and 12 under 35 U.S.C. §102 (a) as being anticipated by Zhou et al. (*J. Cell Biology* 146:1133-1146, September 6, 1999), as set forth at pages 5-6 of the previous Office Action (Paper No. 12, September 3, 2002), remains.

The Declaration under 37 C.F.R. §1.131 submitted on March 3, 2003 in Paper No. 13 is ineffective to overcome the rejection because swearing back of a reference under 37CFR 1.131 may be done by all the inventors, the owner or a party qualified under 1.42, 1.43, or 1.47. However, None of which appear to apply to Lynn Marcus-Wyner. See MPEP 715 (R-1).

#### **VII. Claim Rejections Under 35 U. S. C. § 103 (a)**

The rejection of claims 9, 14, 17, 19, and 20, under 35 U.S.C. §103(a) as being unpatentable over Bordignon et al. (WO 95/06723, March 9, 1995) in view of Zhou et al. (*J. Cell Biology* 146:1133-1146, September 6, 1999), as set forth at pages 7-8 of the previous Office Action (Paper No. 12, September 3, 2002), remains. This is because the Declaration under 37 C.F.R. §1.131 submitted on March 3, 2003 in Paper No. 13 is

ineffective to swearing back of the reference of Zhou et al. and the 103 (a) rejection based upon the combination of Bordignon et al. and Zhou et al. remains.

The rejection of claim 18 under 35 U.S.C. §103(a) as being unpatentable over Bordignon et al. (WO 95/06723, March 9, 1995) in view of Zhou et al. (*J. Cell Biology* 146:1133-1146, September 6, 1999), and further in view of either Persons et al. (*Blood* 90:1777-1786, 1997) or Hildinger et al. (*Gene Therapy* 6:1222-1230, 1999), as set forth at pages 8-9 of the previous Office Action (Paper No. 12, September 3, 2002), remains. This is because the Declaration under 37 C.F.R. §1.131 submitted on March 3, 2003 in Paper No. 13 is ineffective to swearing back of the reference of Zhou et al. and the 103 (a) rejection based upon the combination of Bordignon et al., Zhou et al., and Persons et al. (or Hildinger et al.) remains.

### **VIII. Claim Objections**

Claims 5 and 25-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **IX. Relevant Art**

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

(i) Valenzuela et al. (U. S. Patent No. 5,656,473, August 12, 1997) teach a human muscle specific tyrosine kinase receptor which shares 99.8% sequence identity

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with SEQ ID NO: 2, and a rat muscle specific tyrosine kinase receptor which shares 93.9% sequence identity with SEQ ID NO: 2 (See attached sequence alignment).

(ii) Valenzuela et al. (*IDS*, *Neuron*, 15:573-84, 1995) teach a human muscle specific tyrosine kinase receptor which shares 99.8% sequence identity with SEQ ID NO: 2 (See attached sequence alignment).

## X. Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruixiang Li whose telephone number is (703) 306-0282. The examiner can normally be reached on Monday-Friday, 8:30 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for this Group is (703) 305-3014 or (703) 308-4242.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Ruixiang Li  
Examiner  
May 27, 2003

ELIZABETH KEMMERER  
PRIMARY EXAMINER